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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,702	11/09/2001	Keith W. Diveley	020375-004010US	4413
20350	7590	06/24/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			REAGAN, JAMES A	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,702	DIVELEY, KEITH W.	
	Examiner	Art Unit	
	James A. Reagan	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-7,10,12,13,15,25,29 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-7,10,12,13,15,25,29 and 50-53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment and RCE filed on 12 May 2005.
2. Claims 1, 4, 12, 13, 25 and 29 have been amended.
3. Claims 3, 8, 9, 11, 14, 16-24, 26-28, and 30-49 have been cancelled.
4. Claims 50, 51, 52 and 53 have been added.
5. Claims 1, 2, 4-7, 10, 12, 13, 15, 25, 29, 50, 51, 52 and 53 are pending and have been examined.

RESPONSE TO ARGUMENTS

6. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6, 10, 12, 13, 15, 25, 29, 50, 51, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch (US 5,903,633 A) in view of O'Mahony et al., "Electronic Payment Systems" (1997), and further in view of Banks et al. (US 20020076018 A1).

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

Lorsch, as shown, discloses the following limitations:

- *a payment service provider receiving a set of identifiers from a consumer provider associated with a dial tone service of the consumer provider* (see at least column 1, lines 29-31);
- *the payment service provider receiving a request from a customer of the consumer provider to pay for the dial tone service, wherein the request includes one of the identifiers and a payment* (see at least column 8, lines 34-39);

Lorsch does not specifically disclose:

- *creating an electronic record of the payment and the identifier;*
- *communicating the electronic record to a host computer; and*
- *electronically sending the electronic record from the host computer to a telecommunication switch;*

However, Lorsch, in at least column 8, lines 40-62 discloses adding minutes to the phone card using a POS device, paying for the minutes, debiting the clients checking account, and recording the transaction on a database, essentially disclosing the limitations aforementioned. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the prepaid phone card activations and billing method of Lorsch because it provides an efficient and secure method of offering a simple communication system to a consumer.

Lorsch does not specifically disclose a payment service provider. O'Mahony, in chapter 7 of his book fully discloses micropayment systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the payment techniques of Lorsch with O'Mahony's micropayment technique because it provides both the consumer and the service provider with a third party that excels in providing safe and secure payment systems.

The Combination of Lorsch/O'Mahony does not disclose:

- *the dial tone service is configured to provide direct and uninterrupted access to telecommunication services; and*
- *activating the dial tone service upon receipt of the electronic record by the telecommunication switch wherein communication of the electronic record to the telecommunication switch is configured to provide that the dial tone service is activated substantially contemporaneously with receipt of the payment by the payment service provider;*

Banks, however, in at least paragraphs 0008, 0023, and 0024 does disclose immediate activation of purchased dial tone service as well as *direct and uninterrupted access to the service*. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment techniques of Lorsch/O'Mahony's with Banks' system because it provides both the consumer with Banks improves upon the efficiency of providing dial tone services on demand.

Claim 2:

Lorsch does not specifically disclose *electronically transferring the payment to a bank account of the consumer provider*. However, Lorsch does disclose debiting the clients checking account. Naturally, the amount debited would be credited to the providers account.

Claim 4:

With regard to the limitation of the request is entered into a terminal having a processor, and wherein the electronic record is transferred electronically from the terminal to a host computer, see Lorsch, in at least column 8, lines 40-62, and the rejection of claim 1 above.

Claim 5:

With regard to the limitation of the electronic record is further transmitted from the host computer to the consumer provider, Lorsch effectively discloses payment records and receipts being processed, sent, and stored on the centralized computer, invoice computer, and central database in at least Figure 1 and associated text.

Claim 6:

With regard to the limitation of the set of identifiers are associated with enrollment information obtained from consumers enrolling with the consumer provider, and further comprising electronically sending enrollment information from the consumer provider to the host computer, Lorsch discloses activation of the card in at least column 1, lines 8-12, essentially disclosing enrolling the card and card user based upon the account and PIN of the phone card.

Claim 10:

With regard to the limitation of at least some part of the identifier is associated with a payment amount as determined by the consumer provider, Lorsch, in at least column 1, lines 41-48, discloses an account number associated with a predetermined talk time.

Claim 12:

With regard to the limitations of claim 12, see the rejections of claims 1 and 2 above.

Claim 13:

With regard to the limitations of *at least one terminal having a processor that is capable of communicating with the host computer, and wherein the terminal is configured to receive the identifier, the customer phone number and the payment information and to transmit the identifier, the customer phone number, and the payment information to the host computer*, see the rejections of claims 4 and 5 above.

Claim 15:

With regard to the limitations of:

- *a printer coupled to the terminal to print a receipt showing the payment;*
- *the receipt comprises a sheet of paper having the identifier printed thereon;*
- *the identifier is issued on a receipt comprising a sheet of paper having the identifier printed thereon; and*
- *producing a receipt having an identifier that indicates payment has been made;*

Lorsch discloses a POS terminal in at least Figure 1, plainly disclosing a printing device that prints the transaction and relevant transaction data such as account numbers and payment amounts.

Claim 25:

With regard to the limitations of claim 25, see the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

Claim 29:

With regard to the limitation of *sending the payment to a bank account of the consumer provider, and sending payment information along with the associated identifier to the consumer provider*, see the rejections of claims 1 and 2 above.

Claims 50-53:

With regard to the limitations of:

- *the one of the identifiers comprises at least a phone number associated with the customer.*
- *activation of the dial tone service comprises adding service time to an existing dial tone service associated with the customer telephone number.*

Lorsch discloses adding time to an existing account. It is obvious that a dial tone service includes a phone number.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch in view of Vulcan et al. (US 5,799,072 A).

Claim 7:

Lorsch discloses the prepaid phone card activations and billing method as shown above in the rejection of claim 1. Lorsch does not specifically disclose *periodically receiving updated enrollment information at the host computer*. Vulcan, however, in at least the abstract and other associated text discloses updating a client database on a regular basis, essentially disclosing that personal and account information regarding prepaid phone cards and their users is also easily updated. It would have been obvious to one of ordinary skill in the art at the time of the invention to regularly update their client database because this maintains current contact and billing formation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is (703) 306-9131. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to:

703.305.7687 [Official communications, After Final communications labeled "Box AF"]

703.308.1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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JAR

20 June 2005

